



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,712	11/08/2001	Richard A. Morris	020431.1081	4170
53184	7590	02/23/2006		
i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			EXAMINER FERNANDEZ RIVAS, OMAR F	
			ART UNIT 2129	PAPER NUMBER
DATE MAILED: 02/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/035,712	<b>Applicant(s)</b> MORRIS ET AL.	
	<b>Examiner</b> Omar F. Fernández Rivas	<b>Art Unit</b> 2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-11, 13-21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-11, 13-21 and 23-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office Action is in response to a request for continued examination entered September 23, 2005 for the patent application 10/035,712 filed on November 8, 2001.
2. The Office Actions of July 14, 2005, January 4, 2005 and July 28, 2004 are fully incorporated into this Non-Final Office Action by reference.

### ***Status of Claims***

3. Claims 1, 12 and 22 have been canceled. Claims 2-11, 13-21 and 23-31 have been amended and are pending on this application.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-11, 13-21, 23-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention fails to produce a useful, concrete, and tangible result. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, the acts are not being applied to appropriate subject matter. Shrader, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process. See MPEP 2106 IV B 1.

The Courts have found that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g.,

Art Unit: 2129

*Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Warmerman*, 33 F.3d at 1360, 31 USPQ2d at 1759.

In the present case, the claimed invention is directed to selecting members in a hierarchy. The process recited in the claims only manipulates data inside of a computer. There is no useful, concrete or tangible result from carrying out the invention since there is no application of the claimed invention to an outside process or device.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-11, 13-21 and 23-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Weinberg et al (US Patent #6,587,969, referred to as **Weinberg**).

### **Claims 2, 13 and 23**

Weinberg anticipates a method, a system and software for selecting members in a hierarchy (**Weinberg**: Abstract, L6-15; Examiner's Note (EN): a tree is a hierarchy, nodes are members of the tree), comprising:

receiving input of a user from a member selection interface (**Weinberg**: Abstract, L8-15; C2, L41-56; C56, L52-59; C26, L4-19);

determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data (**Weinberg**: Abstract; C2, L41-56, C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: a dimension is a particular field or screen object of the server screen)

recording the sequence of actions of the user in a member selection script (**Weinberg**: Abstract 1-3; C2, L23-26, C5, L27-31; C21, L35-65; Figs. 1, 6A, 6B, 6C EN: user steps taken during a user session is a sequence of actions of the user. Storing the user steps (or member selections) in memory as a testscript is recording the user actions in a member selection script); and

executing the recorded member selection script to generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, after the hierarchy of members has been modified (**Weinberg**: Abstract; C2, L23-40, C3, L11-36; C5, L24-65; C8, L40-67; C25, L20-49; Fig. 2; EN: modifying nodes is modifying the members);.

**Claims 3, 14 and 24**

Weinberg anticipates one or more of the actions comprise selecting the dimension from which members are to be selected (**Weinberg**: Abstract, L12-15; C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: selecting the screen objects or fields is selecting the dimensions).

**Claims 4, 15 and 25**

Weinberg anticipates one or more of the actions comprise selecting the hierarchy from which members are to be selected (**Weinberg**: Abstract, L12-15; C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: selecting the screen objects or fields is selecting the hierarchy).

**Claims 5, 16 and 26**

Weinberg anticipates selecting or deselecting one or more levels of the hierarchy from which members are to be selected, the members being selectable only from selected levels (**Weinberg**: C3, L14-20; C9, L7-16; C17, L1-26 Figs. 2, 3A, 3B, 4B, 4D, 5D, 5F; EN: nodes on a tree can only be selected in levels depending on their location in the hierarchy).

**Claims 6, 17, and 27**

Weinberg anticipates expanding a member to view the children of the member; and  
the selection of an expanded member causing only the selection of the expanded member (**Weinberg**: C9, L1-16; C17, L1-26; Figs. 3A, 3B, 4B, 4D, 5E).

**Claims 7, 18 and 28**

Weinberg anticipates collapsing a member to hide the children of the member; and the selection of a collapsed member causing the selection of the expanded member and the children of the expanded member (**Weinberg**: C9, L1-16; C17, L1-26; Figs. 3A, 3B, 4B, 4D, 5E).

**Claims 8, 19 and 29**

Weinberg anticipates selecting or deselecting one or more members from the hierarchy (**Weinberg**: Abstract, L12-15; C3, L11-23; C9, L1-16; C17, L1-26; Figs. 3A, 3B, 4B, 4D, 5E).

**Claims 9, 20 and 30**

Weinberg anticipates the one or more actions are recorded in the member selection script using one or more commands, the commands and one or more parameters associated with each command identifying the one or more actions (**Weinberg**: Abstract, L1-3; C2, L23-56; C21, L22-65; Figs. 6A, 6B, 6C).

**Claim 10**

Weinberg anticipates the user manually generates the member selection script (**Weinberg**: Abstract, L1-3; C2, L23-56; C5, L27-31; C25, L20-49; Fig. 1; EN: if the user is making selections, he is manually generating the script or protocol to follow).

**Claims 11, 21 and 31**

Weinberg anticipates the member selection script is automatically generated based on input received from the user using a member selection interface (**Weinberg**: C21, L22-67, C22, L 1-36; Figs. 6A, 6B, 6C).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carpenter et al US Patent #5,421,004

O'Connor et al. US Patent #6,134,539

Slutz US Patent #6,138,112

7. Claims 2-11, 13-21 and 23-31 are rejected.

***Correspondence Information***

8. Any inquires concerning this communication or earlier communications from the examiner should be directed to Omar F. Fernández Rivas, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-2589 or email [omar.fernandezrivas@uspto.gov](mailto:omar.fernandezrivas@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, David Vincent, may be reached at (571) 272-3080.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.



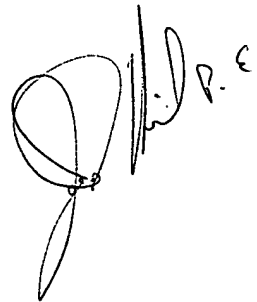
Application/Control Number: 10/035,712  
Art Unit: 2129

Page 8

Omar F. Fernández Rivas  
Patent Examiner  
Artificial Intelligence Art Unit 2129  
United States Department of Commerce  
Patent & Trademark Office

Monday, February 13, 2006

OFR

A handwritten signature in black ink, appearing to read 'OFR', with a stylized flourish extending from the bottom.